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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,530	02/17/2004	Marsha Kent	LR-4001US	1504
39775	7590	01/19/2006	EXAMINER	
SYLMARK, INC. 4929 WILSHIRE BLVD SUITE 500 LOS ANGELES, CA 90010			JOHNSON III, HENRY M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/780,530	KENT ET AL.	
	Examiner	Art Unit	
	Henry M. Johnson, III	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>021704</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The use of the trademark Velcro® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 15, 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, the phrase "unit defining having a handle" is unclear.

Claims 2, 15 and 17 include a trademark. The use of trademarks within a claim renders the metes and bounds of the claim indefinite. Ex parte Simpson, 218 USPQ 1020 (PatBdApp 1981).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

Art Unit: 3739

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-7, 10, 11 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,860,896 to Leber et al. Leber et al. disclose an energy therapy device with LEDs mounted on a substrate (pad) and a control unit (Fig. 2, #110) with an LCD display (fig. 2, # 114). The control unit is interpreted as a housing unit and may be separate from the substrate (Fig. 7) or attached to the substrate (Fig. 12). The lanyard holding the housing around a neck (fig. 7) is broadly interpreted as a handle in the same sense that the flexible straps of the applicant are described as a handle. An electrical cable connects the substrate to the control (Fig. 2, # 106). The substrate may be attached to a body with straps (Fig. 7). The pocket of the integral unit (Fig. 12) is interpreted as capable of storing any excess cable. The pocket is interpreted as a generic fastening means providing the same capability as hook and loop fastening or a press fit.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 3739

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,802,853 to Osendowski in view of U.S. Patent 6,860,896 to Leber et al. Osendowski teaches a hand held therapy device with LEDs in a housing adapted to be positioned in a hand with straps (Fig. 2, #36) attached via slots (Fig. 3, # 32). The upper portion (Fig. 2, # 18) is interpreted as a top shell and the switch (Fig. 2, # 50) is interpreted as a control that is easily accessible to a user. Osendowski does not disclose separating the control portion from the treatment portion. Leber et al. disclose an energy therapy device with LEDs mounted on a substrate (pad) and a control unit (Fig. 2, #110) with an LCD display (fig. 2, # 114). The control unit is interpreted as a housing unit and may be separate from the substrate (Fig. 7) or attached to the substrate (Fig. 12). The lanyard holding the housing around a neck (fig. 7) is broadly interpreted as a handle in the same sense that the flexible straps of the applicant are described as a handle. An electrical cable connects the substrate to the control (Fig. 2, # 106). The substrate may be attached to a body with straps (Fig. 7).

Regarding claims 2-4, the pocket of Leber et al. clearly provides a means for fastening the control unit to the treatment unit and is interpreted as a generic fastening means. Lacking any critically associated with a specific fastening means, the choice of an appropriate means is within routine skill in the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the detachable control with display as taught by Leber et al. in the invention of Osendowski to provide flexibility of use and accessibility to the control when the treatment is in a less accessible area as suggested by Leber et al. as shown in figure 7 where

Art Unit: 3739

the treatment is a back and the control is hung around a users neck. The separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,860,896 to Leber et al. Leber et al. disclose the claimed invention except for an elastic handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a flexible, elastic handle, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 9 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,860,896 to Leber et al. as applied to claim 6 above, and further in view of U.S. Patent 6,802,853 to Osendowski. Leber et al. are discussed above but do not disclose specific handle configurations. Osendowski teaches a shell like housing with straps attached via slots as discussed above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the handle configuration as taught by Osendowski to house the invention of Leber et al. to provide a hand held device with controls easily accessible.

Regarding claims 12-15, the pocket of Leber et al. clearly provides a means for fastening the control unit to the treatment unit and is interpreted as a generic fastening means. Lacking any critically associated with a specific fastening means, the choice of an appropriate means is within routine skill in the art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3739

U.S. Patent Application Publication 2002/0143373 to Courtage et al. teaches a light therapy device with a control unit separate or attached.

U.S. Patent Application Publication 2003/0187486 to Savage et al. teaches LEDs attached to a body using hook and loop fastening and a separate control unit.

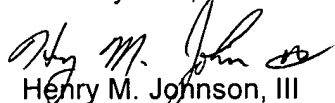
U.S. Patent 6,811,563 to Savage et al. teaches straps to attach a therapy unit to a body.

U.S. Patent 6,743,249 to Alden teaches a non-integral control for a light therapy device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry M. Johnson, III  
Patent Examiner  
Art Unit 3739